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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,900	11/25/2003	Charles L. Tazzia	IN-5653	1184
26922	7590	06/13/2006	EXAMINER	
BASF CORPORATION 1609 BIDDLE AVENUE WYANDOTTE, MI 48192			SERGENT, RABON A	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/723,900

Applicant(s)

TAZZIA, CHARLES L.

Examiner

Rabon Sergeant

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, and 6-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Claims 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claim 7, it is unclear what determines if the “salting” step is necessary. It is unclear to what extent the limitation is optional. The examiner has considered applicant’s response; however, it is not clear that applicant has addressed the examiner’s concerns. The question posed by the examiner concerns what determines if the “salting step” is necessary; and it appears from applicant’s response that the step is always necessary when dispersing the resin in water; therefore, it remains unclear how to interpret the “if necessary” language.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3, 4, 6, 11, and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-10 of copending Application No. 10/723,899. Although the conflicting claims are not identical, they are not patentably distinct from each other because the curing agents of the copending application encompass uretdione compounds and the coatings encompass electrodepositable coatings.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 4, and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. (US 2003/0150730) in view of O'Connor et al. ('684) or Gras et al. ('613).

Hartung et al. disclose aqueous electrodepositable coating compositions, wherein an externally crosslinking binder, such as a cationic group containing active hydrogen functional epoxy resin, and crosslinking agent are homogeneously mixed as melts and subsequently emulsified into an aqueous medium to yield the coating composition. The reference discloses

that the crosslinking agent may be selected from uretdione containing polyisocyanates, wherein dimerized isophorone diisocyanate is disclosed as being one of the preferred crosslinking agents. See paragraphs [0007]-[0017], [0026], [0034], and [0044].

6. Though the primary reference discloses that a preferred crosslinking agent for the coatings is a dimerized or uretdione containing isocyanate, the reference fails to disclose an uretdione crosslinking agent that corresponds to applicant's claimed uretdione compound. However, uretdione containing crosslinking agents having applicant's claimed structure, wherein the uretdione diisocyanate is modified with a polyol compound to introduce urethane groups into the uretdione structure, were known at the time of invention. This position is supported by the teachings of O'Connor et al. and Gras et al. O'Connor et al. disclose that uretdione containing polyurethane oligomers are useful for the production of aqueous polyurethane dispersion coatings. See abstract and columns 2 and 4 within O'Connor et al. Gras et al. disclose polyaddition products containing uretdione groups which are useful for the production of powder coating and stoving enamels. See abstract. Gras et al. further disclose that the uretdione polyaddition products may be reacted with active hydrogen functional epoxy resins. See column 4, lines 26 and 27. Therefore, given the teachings concerning the use of uretdione containing crosslinking agents within Hartung et al. and the disclosed utilities for the polyaddition compounds within the secondary references, the position is taken that one of ordinary skill in the art would have been motivated to employ the uretdione containing polyaddition compounds of the secondary references as the crosslinking agent of Hartung et al.

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Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent  
June 9, 2006



**RABON SERGENT  
PRIMARY EXAMINER**